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REMARKS

This Application has been carefully reviewed in light of the Office Action mailed June 14, 2005. Claims 1-21 currently stand rejected.

Section 103 Rejections

Claims 1-21 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2001/0032254, listing Hawkins as inventor ("*Hawkins*") in view of U.S. Patent 6,684,088, granted to Halahmi ("*Halahmi*") and further in view of U.S. Patent 6,725,303 granted to Hoguta, et al. ("*Hoguta*"). Applicants respectfully traverse these rejections.

Independent Claim 1 is allowable because the proposed combination of *Hawkins*, *Halahmi*, and *Hoguta* fail to disclose providing a service module operable to maintain a list of registered component interfaces as recited in claim 1. The Office Action recognizes that neither *Hawkins* nor *Halahmi* disclose this limitation, but the Office Action cites *Hoguta*'s customizing device 122 as disclosing this limitation. However, this is incorrect because *Hoguta*'s customizing device 122 does not maintain a list of registered component interfaces. Rather, *Hoguta*'s customizing device 122 provides a customized use of and access to the functions and features of a network 101. In particular, *Hoguta*'s customizing device 122 can be used for customizing a user interface for a subscriber, but this is not maintaining a list of registered component interfaces. Accordingly, for at least this reason, Applicants submit that Claim 1 is allowable as are Claims 2-5, dependents of Claim 1. Claims 5, 9, 13, and 21 are allowable for analogous reasons as are Claims 6-8, 10-12, and 14-20, dependents of Claims 5, 9, and 13.

Assuming, for the sake of argument, that *Hawkins*, *Halahmi*, and *Hoguta*, disclosed each and every limitation of independent Claim 1, Applicants questions the Office Action's proposed combination and modification of the references. Noticeably absent in the Office Action is reasoning why one of ordinary skill in the art would engage in a modification of the proxy servers of *Hawkins* or *Halahmi* to include *Hoguta*'s customizing device 122. *Hoguta* discusses the connection of a customizing device 122 within a network 101. To this end, the Office Action indicates that "[t]his would have allowed users to establish personal connections with the private

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network, and also would have provided access to varied levels of network capabilities and services from an assortment of devices on the network". However, neither the Office Action nor *Hoguta* provide a discussion as to how such a customizing device 122 could work in a proxy server or why one of ordinary skill in the art would be motivated to place such a customizing device 122 in a proxy server. Further, none of the references provide an indication that this proposed combination would have a reasonable likelihood of success.¹

The conclusory reasoning provided in the Office Action falls well short of the required evidence of a motivation to combine and/or modify prior art references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See, e.g., *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at the claimed...salt."). To this end, the Examiner is reminded that "[t]he factual inquiry whether to combine references must be thorough and searching." (*In re Sang-Su Lee*, 277 F.3d 1338, 1343). And that "[an] examiner's conclusory statements . . . do not adequately address the issue of motivation to combine." *Id.* Furthermore, simple hindsight speculation that "it would have been obvious" to make the proposed combination is insufficient under M.P.E.P.² guidelines and governing Federal Circuit case law.³ Moreover, such statements

¹ See M.P.E.P. §2143 ("The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).")

² See, e.g., M.P.E.P. §2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.")

³ For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight. 175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted).

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and assumptions are inadequate to support a finding of motivation, which is a factual question that cannot be resolved on "subjective belief and unknown authority."⁴

Applicants additionally submit that the Examiner has improperly picked features from the references to the exclusion of the teachings of remainder of such references. To this end, Applicants respectfully remind the Examiner that in making a determination of obviousness, "the prior art as a whole must be considered. The teachings are to be viewed as they would have been viewed by one of ordinary skill." *In re Hedges*, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986) (emphasis added). "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *Id.*

In the Examiner's "picking" of features from the references, the Applicants point out that each of the systems in each of the references are specifically designed for a particular purpose. For example, the system in *Hawkins* is designed to convert wireless queries into Internet compatible protocols, which obtain a response that is converted into a wireless response. *See Hawkins* abstract. The system in *Halahmi* is used to transmit email messages and display the contents of such messages on a low bandwidth device. *See Halahmi* abstract. The system in *Hoguta* is used to provide a personalized subscriber connection from a variety of different terminals. *See Hoguta* abstract. Applicants submit that features of these systems do not lend themselves in an obvious manner to being individually "picked" out for recombination without the Applicants' disclosure in hand. Such is evident, for example, as described above with reference to the lack of a motivation to combine features from *Hoguta* (customizing device 122) with features from *Hawkins* and *Halahmi*. For at least these additional reasons, Applicants submit that Claims 1-21 are allowable.

⁴ *See In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

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CONCLUSION

For the foregoing reasons and for reasons clearly apparent, Applicants respectfully request allowance of all pending claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stand ready to conduct such a conference at the convenience of the Examiner.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 19-2179 of Siemens Corporation.

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